

### **REMARKS**

Entry of the amendments is respectfully requested. Claims 11, 12, 18, 19, 25, 26, and 27 have been amended. Claims 30-40 have been cancelled. No new claims have been added. Claims 1-16 and 18-29 are now pending in the application and presented for reconsideration. Favorable reconsideration and allowance of this application are respectfully requested in light of the foregoing amendments and the remarks that follow.

#### **1. Allowable Subject Matter**

In the Office Action, the Examiner allowed claims 1-16. The Examiner indicates additional subject matter in each of claims 19-24, 26, and 27. Correspondingly, claims 19-24, 26, and 27 stand objected to as depending from a rejected base claim; each would be allowable if rewritten in independent form including all limitations of the base and any intervening claims (Office Action dated 8/2/2007, Page 3, ¶ 5).

In accordance therewith, Applicant rewrites claim 19 to include all limitations of the base claim, in the form the base claim embodied during the indication of allowable subject matter, whereby it is now allowable. Claims 20-24, 26, and 27 are allowable as depending from allowable claim 19, directly or indirectly, as well as each on its own merits.

#### **2. Claims Objections**

In the Office Action, the Examiner objected to claims 11, 12, 18, and 25-27 because of certain informalities. Applicant has made the appropriate corrections by adopting all of the Examiner's suggestions, thus resolving all such issues.

#### **3. Claim Rejections Under 35 U.S.C. §102**

In the Office Action, claims 18, 25, 28, and 29 stand rejected under 35 U.S.C. §102(b) as being anticipated by Shaputis, U.S. Patent No. 4,068,106 (the '106 patent). Applicant amends independent claim 18, obviating the rejection.

Independent claim 18 is directed toward a drive roll with opposing sides and an outer circumferential surface extending therebetween. At least one rim extends radially outwardly from and at least one channel extends radially into the outer circumferential surface. The radially extending rims are adjacent the first and second sides so that *when a pair of radially aligned drive rolls are brought into contact with each other, they touch only at the respective rims adjacent the sides, defining a clearance between remaining aligned portions thereof.*

The '106 patent does not and cannot disclose a drive roll with radially extending rims that are adjacent opposing sides, such that when radially aligned and brought into contact with a like drive roll, they only contact each other at the rims adjacent the sides and define a clearance between the remaining aligned portions.

The '106 patent discloses a prior art drive roll 44 (FIG. 2) that has a uniform diameter between first and second side surfaces and 3 wire conveying V-grooves, spaced axially from each other, that extend into the outer circumferential surface. The improved technology disclosed in the '106 patent is providing multiple thin, wafer-like drive roll segments 60 that are of the same size and configuration, and stack up axially next to each other. In this configuration, the discrete analogously sized and configured drive roll segments 60 are interchangeable, whereby:

-- should the groove on one of the roller segments become worn through usage, *the plural roller segments need only be rearranged in a different side-by-side relationship so as to present the groove on another roller segment in position to properly engage the consumable wire.* Thus, no spacer members need be employed on the drive shaft, due to the simple shifting and rearrangement of the roller segments. -- (Col. 2, Lines 18-26, emphasis added).

Like the prior art drive roll 44 (FIG. 2), the drive roll assembly 10 (FIG. 3) has a uniform diameter between first and second side surfaces and 3 wire conveying grooves that extend into the outer circumferential surface. Indeed, the stated objective of the '106 patent to provide

*interchangeable* individual drive roll segments **requires** that the individual segments have the same diameters.

Applicant therefore submits that the '106 patent teaches strongly away from the invention of claim 18, which calls for a drive roll that when ***radially aligned with a like drive roll, touch only at the respective rims adjacent the sides, defining a clearance between remaining aligned portions thereof.*** This requires rims, adjacent the sides, which are of dissimilar (and ***greater***) diameter(s) than the rest of the drive roll body. Modifying the '106 patent in such a manner runs afoul of its objective of providing analogous ***interchangeable*** drive roll segments. It is noted that if "proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). See also MPEP2143.01(V). Amended independent claim 18 is therefore believed to be novel and non-obvious over the cited prior art for this reason.

Nor does the '106 patent disclose or suggest each and every limitation of claims 25, 28, and 29 whereby these claims are allowable as depending from allowable claim 18 as well as on their own merits.

## CONCLUSION

It is submitted that the objections to the claims are resolved. It is further submitted that claims 1-16 and 18-29 are in compliance with 35 U.S.C. §§ 102, 103, and 112, and each defines patentable subject matter. A Notice of Allowance is therefore respectfully requested.

No fees are believed to be payable with this communication. Nevertheless, should the Examiner consider any fees to be payable in conjunction with this or any future communication, the director is authorized to charge any fee or credit any overpayment to Deposit Account No. 50-1170.

The Examiner is invited to contact the undersigned by telephone if it would help expedite the prosecution and allowance of this application.

Respectively submitted,



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